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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,833	11/16/2001	Hiroshi Koga	862.C2437	7585

5514 7590 05/09/2007  
FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER
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LANIER, BENJAMIN E

ART UNIT	PAPER NUMBER
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2132

MAIL DATE	DELIVERY MODE
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05/09/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/987,833

Applicant(s)

KOGA, HIROSHI

Examiner

Benjamin E. Lanier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7,27-29,32-35,38 and 41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6,33-35,38 and 41 is/are allowed.
- 6) ☒ Claim(s) 7,27-29 and 32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment filed 21 March 2007 amends claims 1, 7, 27, 33, and 41. Claims 8-15 have been cancelled.

### ***Response to Arguments***

2. Applicant's argument that Gacek does not disclose or suggest "a client apparatus including a printer driver which obtains information from electronic data identifying an application which issued an instruction to print electronic data using an application interface (API), which executes an authentication request for approving an output request of the electronic data based on the information, and which controls a print process so as to permit or stop generation of print data from electronic data in response to a success or failure of the authentication " has been fully considered and are persuasive. The previous rejections of claims 1-7, 27-29, 32-35, 38, and 41 under 103(a) have been withdrawn.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 7, 27-29, 32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 7, 27-29, and 32 are directed towards means that are described in the specification as being software (Page 65, lines 7-13 & Page 66, lines 11-16). "Functional descriptive material consists of data structures and computer programs which impart functionality when employed as a computer component." (MPEP 2106). When functional descriptive material is recorded on some computer-readable medium it becomes structurally and

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functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035. The claims should be amended to specify that the claimed means are embodied on a computer-readable storage medium.

***Allowable Subject Matter***

5. Claims 1-6, 33-35, 38, 41 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: The claimed invention generally concerns authentication in a print process executed by a printer driver in a client apparatus. The printer driver in the client apparatus obtains information identifying an application which issued an instruction to print electronic data using an application interface (API) called by the printer driver. The printer driver also executes an authentication request for approving an output process of the electronic data based on the information identifying the application. Additionally, the printer driver is used to control a print process so as to permit generation of print data from the electronic data in response to a success of the authentication, or to stop generation of print data from the electronic data in response to a failure of the authentication.

The prior art does not disclose or make obvious the claimed features described above, wherein this composite recitation incorporated into independent claims 1, 33, and 41, renders these claims, and their dependants, allowable.

***Conclusion***

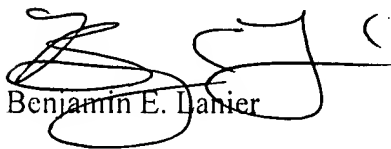
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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E. Lanier whose telephone number is 571-272-3805.

The examiner can normally be reached on M-Th 7:30am-5:00pm, F 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Benjamin E. Lanier